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NORRIS, MCLAUGHLIN & MARCUS, PA			EXAMINER	
875 THIRD AVENUE			GOFF II, JOHN L	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNHARD MUSSIG

Appeal 2009-2603
Application 09/156,886
U.S. Patent Publication 2001/0004494
Technology Center 1700

Decided¹: April 14, 2009

Before: FRED E. McKELVEY, *Senior Administrative Patent Judge*, and RICHARD E. SCHAFER and RICHARD TORCZON, *Administrative Patent Judges*.

McKELVEY, *Senior Administrative Patent Judge*.

DECISION ON APPEAL

- 1
- 2 A. Statement of the case
- 3 Mussig and the real party in interest (tesa AG—formerly Beirsdorf
- 4 AG) (Mussig), seek review under 35 U.S.C. § 134(a) of a final rejection
- 5 (mailed 18 March 2005).
- 6 Claim 37-55 are in the application.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1 The Examiner relies on the following prior art:

Dobashi	5,643,676	1 Jul 1997
Koga	EP 0 661 364 A2	7 May 1995

2

3 We have jurisdiction under 35 U.S.C. § 134(a).

4

5 B. Discussion

6 Claims 37-55 are on appeal.

7 Claim 37 is an independent claim.

8 Claims 38-55 are dependent claims.

9 Claim 37, reproduced from the Claims Appendix of the Corrected
10 Appeal Brief (filed 12 Dec. 2006), reads [bracketed matter, italics and some
11 indentation added]:

12 A method

13 [1] for protecting the paint finish of a vehicle or

14 [2] for protecting a painted vehicle component

15 against soiling and damage during assembly, transportation or

16 storage,

17 said method comprising applying to said vehicle or

18 vehicle component a self-adhesive protective film,

19 said self-adhesive protective film comprising:

20 a) a backing film; and

21 b) an adhesive composition coated on said backing film,

1 wherein the adhesive composition comprises [1] a
2 copolymer of at least two different α -olefins having 2 to 12
3 carbon atoms and [2] at least one further comonomer,
4 said *further comonomer being a diene*,
5 said adhesive composition not containing 75 mol-% or
6 more of any single α -olefin,
7 the copolymer having a Mooney viscosity ML (1+4) 125
8 $^{\circ}\text{C}$ of less than 50.

9 The rejection is based on the combined disclosures of Koga and
10 Dobashi.

11 One element of the claimed method is the use of an adhesive
12 composition comprising [1] a copolymer of at least two different α -olefins
13 having 2 to 12 carbon atoms and [2] at least one further comonomer, said
14 further comonomer being a diene.

15 Mussig maintains (Reply Brief, page 2), and we agree, that Koga does
16 not describe a composition having a copolymer wherein at least one further
17 comonomer is a diene. The Examiner does not rely on Dobashi for a
18 teaching of the further comonomer.

19 Suitable dienes are those common for the preparation of EPDM
20 rubber, examples being (1) 1,4-hexadiene, (2) dicyclopentadiene or, in
21 particular, (3) 5-ethylidene-2-norbornene (ENB). The proportion of diene in
22 the polymer is preferably between 0.5 and 10% by weight. Specification,
23 page 2:14-18.

1 What Koga describes is an adhesive comprising a mixture of (1) a
2 copolymer of various α -olefins and (2) certain polymers made *inter alia*
3 from butadiene—which is a diene.

4 After considering Koga as a whole, including the portions of Koga
5 cited in the Examiner's Answer, insofar as we can tell nothing in Koga
6 describes a copolymer made from two α -olefins monomers and a diene
7 monomer.

8 An essential element of claim 37 being missing from the prior art
9 relied upon by the Examiner, renders the Examiner's obviousness holding
10 unsupported factually by the evidence.

11 Claims 38-55 are dependent directly or indirectly on independent
12 claim 37. If broad claim 37 is not unpatentable over prior art relied upon by
13 the Examiner, then narrower claims 38-55 likewise cannot be unpatentable
14 over that prior art.

15 Our rationale for reversal makes it unnecessary to consider the
16 "evidence" offered by Mussig to allegedly show "unexpected results." See
17 Appeal Brief, pages 9-15.

18 C. Decision

19 Upon consideration of the appeal, and for the reasons given herein,
20 it is

21 ORDERED that the decision of the Examiner rejecting
22 claims 37-55 over the prior art is *reversed*

REVERSED

Appeal 2009-2603
Application 09/156,886

MAT

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